REMARKS

This responds to the Office Action mailed on October 19, 2006.

Claims 95, 102, 108, and 114 are amended, claims 1-94 were previously canceled, without prejudice to the Applicant; as a result, claims 95-119 are now pending in this application.

§103 Rejection of the Claims

Claims 95-105 and 107-118 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Feedback Forum (eBay.com, November 10, 1999 via web.archive.org) in view of Fuerst (U.S. 6,189,029). It is of course fundamental that in order to sustain an obviousness rejection that each and every step or element in the rejected claims must be taught or suggested in the proposed combination of references. Furthermore, there must be some motivation by one or ordinary skill in the art to combine the references in the manner recited by the Examiner.

Applicant would further like to point out that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art recited also suggests in some manner the desirability of the proposed combination. *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Applicant would also like to note that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998). This requirement is rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in 35 U.S.C. § 103. See id, at 1344-45." *In re Kahn*, No. 04-1616 (Fed. Cir. March 22, 2006).

It has also been held that when the primary teachings of one reference is negated or taught against or taught away from another reference in the proposed combination, then it is common sense that one of ordinary skill in the art would not have been motivated to combine the references in the manner being proposed, because in so doing the very teachings that are asserted to be complimentary are by definition not complimentary to one another. Thus, there is no motivation by one of ordinary skill in the art to combine the references. It is also the case that

the intended functions of the references being combined cannot be destroyed when combined. *See In re Grasselli*, 713 F.2d 731, 743; 218 USPQ 769, 779 (Fed. Cir. 1983).

There is no teaching in Fuerst where feedback is provided in a feedback forum and at the request of one of the users. Moreover, the feedback is not left about a user it is left about a survey. The types of feedback discussed in the Feedback Forum and Fuerst are not compatible with one another.

Specifically, Fuerst does not provide feedback about users it is a survey tool and there is no indication of a feedback forum in either reference. Moreover, the two references are not compatible with one another. That is, just because two references can be combined does not mean it is proper to do so, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998). This requirement is rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in 35 U.S.C. § 103. See id, at 1344-45." *In re Kahn*, No. 04-1616 (Fed. Cir. March 22, 2006).

See column 2 lines 31-41 of Fuerst. Surveys are created by constructors about topics not about users. Also see column 2 lines 56-62, survey links are sent to the users that fill out the surveys. So, the survey is not requested by a user it is sent to the user and the user is asked to complete it. See also column 10 lines 22-40, survey questions are pushed to the users not requested by the users.

Combining Fuerst with Feedback Forum is impractical and runs against the teachings of Fuerst. Fuerst desires to obtain survey answers from users when questions are pushed to the users. Conversely, Feedback Forum is desired to get feedback about users involved in a transaction with one another and at the request of the user. The two types of alleged feedback (surveys in Fuerst) are not compatible with one another. Consequently, one of ordinary skill in the art would not have been motivated to combine the two references because in doing so, the creative nature and specificity and open-endedness of survey questions and responses would be lost. Essentially, Applicants feedback forum is about online reputation as is clearly apparent from the context of the claim language, such as "feedback" supplied by a "first user" that it to be associated with a "second user" and "with respect to the online payment transaction." Fuerst is

not even remotely related to reputation and there can be no language or teaching found in Fuerst that would remotely suggest this.

Additionally, the independent claims now permit the user that is the subject of being associated with a predefined feedback comment to also leave a response comment. Support for this may be found in many locations within the original filed specification, including the first full paragraph of page 5 in the original files specification. There is no interactive and iterative ability of this nature discussed in either of the references.

Consequently, Applicant asserts that the references fail to teach each and every limitation in the amended independent claims and that the two references are not permissible in the first instance, since such a combination runs contrary to the teachings of the survey features in Fuerst. Thus, the rejections should be withdrawn and the claims allowed. Applicants respectfully request an indication of the same.

Claims 106 and 119 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Feedback Forum in view of Fuerst, and further in view of Bayer et al. (U.S. 6,311,190). Claims 106 and 119 are dependent from independent claims 102 and 114; thus, for the amendments and remarks presented above with respect to claims 102 and 114, the rejections of claims 106 and119 should be withdrawn. Applicant respectfully requests an indication of the same.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 23 day of January 2007.

Peter Rebuffoni
Name

Signature